

**REMARKS**

Claims 1-20 are all the claims pending in the application. Claims 1 and 15 have been amended. Claims 17-20 are new.

Support for Claims 1 and 15 can be found in the specification, such as on page 5. Support for Claims 17 and 18 can be found in the specification such as on page 5. Support for Claims 19-20 can be found in the specification, such as on page 7. Therefore, no new matter has been added.

Further, Table 1 on page 29 of the specification has been amended. The “Binder of the release layer” column for “C. Ex. 1” has been amended from “No release layer formed” to “A.” The “Binder of transfer layer column” for C. Ex. 1. has been amended from “A” to “B.” The “Interlayer adhesion between release layer/cushion layer (g/cm)” has been amended from “25” to “-.” Support for each of the amendments to Table 1 is found in the specification. For example, the specification at page 28, lines 15-16 describes that Comparative Example 1 was conducted in the same manner as Example 1, except that the cushion layer was not formed. Therefore no new matter has been added.

**I. Claim Rejections - 35 U.S.C. § 102**

Claims 1-6, 9-12 have been rejected under 35 U.S.C. 102(b) as allegedly being anticipated by USPN2000-001044 to Kenjiro et al.

The Office Action describes that the rejection is based on “Kenjiro et al (USPN2000-001044).” It appears that the Examiner has mistaken JP 2000-001044 to Kenjiro KURODA, et al. (“JP ‘044”) to be USPN2000-001044. We accordingly tailor our remarks below to JP ‘044.

Claim 1 presently recites that the cushion layer has a TMA softening point of 60 °C or below.

In contrast, JP '044 describes an intermediate image receiving medium having a base material (11), a mold releasing layer (14), a separating layer (13), and the image receiving layer (12). *See*, paragraph [0018] of the English translation of JP '044. Further, JP '044 discloses that the mold releasing layer (14) uses silicone resin, acrylic resin, melamine resin, epoxy resin, fluorocarbon resin and so on. *See*, paragraph [0022] of the English translation of JP '044.

An English translation of the specification of JP '044 is submitted herewith.

Applicants respectfully submit that the mold releasing layer (14) is different from the cushion layer having a TMA softening point of 60 °C or below. Paragraph [0018] of the English translation for JP '044 fails to explicitly describe that the mold release layer (14) has a TMA softening point of 60 °C or below. Further, JP '044 fails to explicitly describe that the TMA softening point of silicone resin, acrylic resin, melamine resin, epoxy resin, and fluorocarbon resin.

Further, Applicants respectfully submit that JP '044 fails to inherently describe that its mold releasing layer (14) has a TMA softening point of 60 °C or below. The disclosure of a mold releasing layer (14) in JP '044 fails to inherently describe, by itself, a TMA softening point of 60 °C or below. Further, the disclosure of silicone resin, acrylic resin, melamine resin, epoxy resin, and fluorocarbon resin fails to inherently describe a TMA softening point of 60 °C or below. Not all silicone resin, acrylic resin, melamine resin, epoxy resin, and fluorocarbon resin have a TMA softening point of 60 °C or below.

Claims 2-6 and 9-12 depend directly or indirectly from Claim 1. In this regard, Claims 2-6 and 9-12 are patentable for at least the same reasons as Claim 1.

## **II. Claim Rejections - 35 U.S.C. § 103**

### A. Claims 7 and 8

Claims 7 and 8 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over JP '044 in view of US Patent No. 5,955,167 to Onishi et al. ("Onishi '167").

Claims 7 and 8 depend from Claim 1. Claim 1 presently recites that the cushion layer has a TMA softening point of 60 °C or below.

As described above, JP '044 is deficient in that it fails to teach or suggest that the mold releasing layer (14) thereof has a TMA softening point of 60 °C or below. Onishi '167 is relied upon for the following disclosure:

[t]he coverage of the adhesive is preferably in the range of from 5 to 50 g/m<sup>2</sup> (on a dry basis), more preferably in the range of from about 10 to 30 g/m<sup>2</sup>.

*See*, Onishi '167, col. 7, lines 43-45.

Accordingly, Applicants respectfully submit that Onishi '167 fails to make up for the deficiency in JP '044. Onishi '167 at column 7, lines 43-45 fails to teach or suggest a TMA softening point of 60 °C or below. JP '044 fails to teach or suggest a TMA softening point of 60 °C or below because a person of ordinary skill in the art would not have been motivated to modify the mold releasing layer (14) to have a TMA softening point of 60 °C or below. JP '044 fails to disclose the TMA softening point of 60 °C or below as a result-effective variable.

B. Claims 13 and 14

Claims 13 and 14 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over JP '044 in view of US Patent No. 6,652,928 to Sato et al. ("Sato '928").

Claims 13 and 14, depend from Claim 1. Claim 1 presently recites that the cushion layer has a TMA softening point of 60 °C or below.

As described above, JP '044 is deficient in that it fails to teach or suggest that the mold releasing layer (14) thereof has a TMA softening point of 60 °C or below. Sato '928 is relied upon for the disclosure of a thermoplastic resin having a particle size of 0.5 to 100 µm and a melting point of 70 to 200 °C. *See, e.g.*, Sato '928, col. 8, lines 16 -24.

Accordingly, Applicants respectfully submit that Sato '928 fails to make up for the deficiency in JP '044. Sato '928 at column 8, lines 16-24 fails to teach or suggest a TMA softening point of 60 °C or below. JP '044 fails to teach or suggest a TMA softening point of 60 °C or below because a person of ordinary skill in the art would not have been motivated to modify the mold releasing layer (14) to have a TMA softening point of 60 °C or below. JP '044 fails to disclose the TMA softening point of 60 °C or below as a result-effective variable.

C. Claims 15 and 16

Claims 15 and 16 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over JP '044 in view of US 2004/0041894 to Martin et al ("Martin '894").

Claim 15 recites that the cushion layer has a TMA softening point of 60 °C or below. Further, Claim 15 recites that the image formation method entails heating and pressuring.

However, as described above, JP '044 is deficient in that it fails to teach or suggest that the mold releasing layer (14) thereof has a TMA softening point of 60 °C or below. Martin '894 is relied upon for its teaching that "heat and/or pressure is used to 'transfer' the dye." *See*, Martin '894, col. 1, paragraph [0004].

Accordingly, Applicants respectfully submit that Martin '894 fails to make up for the deficiency in JP '044. Martin '894 at column 1, paragraph [0007] fails to teach or suggest a TMA softening point of 60 °C or below. JP '044 fails to teach or suggest a TMA softening point of 60 °C or below because a person of ordinary skill in the art would not have been motivated to modify the mold releasing layer (14) to have a TMA softening point of 60 °C or below. JP '044 fails to disclose the TMA softening point of 60 °C or below as a result-effective variable.

Further, the fact that JP '044 and Martin '894 can be combined, if combinable at all, is not sufficient to establish a *prima facie* case of obviousness. MPEP 2143.01(III). In the present case, the rejection is based on that pressure alone is an equivalent of pressure and heat, if equivalent at all. Whether or not heat and pressure can replace pressure alone, there is no motivation to modify the process disclosed in JP '044. A teaching in Martin '894 suggesting the advantages of using both pressure and heating had not been identified.

Further, Claim 16 depends from Claim 15. Therefore, Claim 15 is patentable for at least the same reasons as Claim 15.

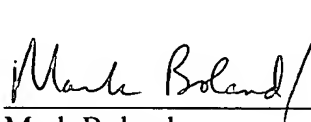
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/755,471  
Attorney Docket No. Q78638

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CUSTOMER NUMBER

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